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OFFICE OF PETITIONS

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In re Application of	:	
Kladders et al.	:	
Application No. 10/757047	:	DECISION ON APPLICATION
Filing or 371(c) Date: 01/14/2004	:	FOR PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
01-1449	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed October 1, 2010. Applicants submit that the correct patent term adjustment is 1278 days, not 1227 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. The basis for Applicants' request is (1) an assertion that the Office erred in calculating an adjustment of 1068 days pursuant to 37 CFR 1.702(a)(1); (2) an assertion that the Office erred in failing to calculate a reduction of 11 days pursuant to 37 CFR 1.704(b), and (3) the Office will take in excess of three years to issue this patent. The Application for Patent Term Adjustment is properly treated under 37 C.F.R. § 1.705(b).

The Application for Patent Term Adjustment under 37 CFR 1.705(b), as it relates to the assertion that the Office erred in calculating an adjustment of 1068 days pursuant to 37 CFR 1.702(a)(1), and an assertion that the Office erred in failing to calculate a reduction of 11 days pursuant to 37 CFR 1.704(b), is **GRANTED**.

The Application for Patent Term under 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

BACKGROUND

The application was filed on January 14, 2004. On July 1, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 1227 days.

On October 1, 2010, applicants timely submitted the present request for reconsideration of patent term adjustment¹. Applicants assert that the Office erred in calculating an adjustment of 1068 days pursuant to 37 CFR 1.702(a)(1), in connection with the mailing of a non-final Office action on April 17, 2007. Applicants provide that the application was filed under 35 U.S.C. § 111(a), and the day after the date that is 14 months after the date on which the application was filed is March 15, 2005. The first Office action under 35 U.S.C. 132 was mailed on April 17, 2007, which is 764 days after the date that is 14 months after the date on which the application was filed. As such, Applicants provide that the adjustment pursuant to 37 CFR §§ 1.702(a)(1) and 1.703(a)(1) is 764 days.

Applicants also aver that the Office erred in failing to calculate an adjustment 11 days in connection with the filing of a response to a final Office action mailed October 4, 2007, to which a response was not filed until January 15, 2008, three months and 11 days after the mail date of the final Office action. Pursuant to 37 CFR 1.704(b), Applicants provide that an 11 day reduction is appropriate.

Applicants do not dispute an adjustment of 165 days pursuant to 37 CFR 1.702(a)(4), or a reduction of 6 days pursuant to 37 CFR 1.704(b).

OPINION

Applicants' arguments have been carefully considered. A review of Office records confirm that a first Office action under 35 U.S.C. 132 was mailed on April 17, 2007, 14 months and 764 days after the date on which the application was filed under 35 U.S.C. § 111(a). The Office agrees that the adjustment pursuant to 37 CFR §§ 1.702(a)(1) and 1.703(a)(1) is 764 days.

Office records also confirm that a final Office action was mailed October 4, 2007, to which a response was filed on January 15, 2008, three months and 11 days after the mail date of the final Office action. Pursuant to 37 CFR 1.704(b), a reduction of 11 days is appropriate.

In view thereof, the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is nine hundred twelve (912) days, subject to any terminal disclaimer.

With regard to the argument under 37 CFR 1.702(b), knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected

¹ Office records show that the Issue Fee payment was received in the Office on October 1, 2010.

issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee².

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight
Director
Office of Petitions

² For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.



Patent Term Adjustments



PTA/PTE Information Patent Term Adjustment Patent Term Extension

Application Number*: 10757047 Search Explanation of PTA Calculation Explanation of PTE Calculation

PTA Calculations for Application: 10757047

Application Filing Date 01/14/2004	Overlapping Days Between (A and B) or (A and C) 0
Issue Date of Patent	Non-Overlapping USPTO Delays: 1233
A Delays: 1233	PTO Manual Adjustment: 315
B Delays: 0	Applicant Delay (APPL): 5
C Delays: 0	Total PTA (days): 912

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
106	12/12/2010		PD28	Adjustment of PTA Calculation by PTO			
96	07/01/2010		NN/-	Mail Notice of Allowance			0
95	06/29/2010		N/-	Notice of Allowance Data Verification Completed			0
94	06/24/2010		IREV	Issue Revision Completed			0
93	06/24/2010		DVER	Document Verification			0
92	06/24/2010		EXA	Examiner's Amendment Communication			0
91	06/24/2010		CHTA	Notice of Allowability			0
89	05/25/2010		FWDX	Date Forwarded to Examiner			0
90	05/18/2010		C614	New or Additional Drawing Filed			0
88	05/18/2010		A/-	Response after Non-Final Action			0
87	05/17/2010		ENL_NTF	Email Notification			0
86	05/17/2010		MEKIN	Mail Examiner Interview Summary (PTOL - 413)			0
85	05/17/2010		EXIN	Examiner Interview Summary Record (PTOL - 413)			0
84	02/18/2010		ELC_RVW	Electronic Review			0
83	02/18/2010		ENL_NTF	Email Notification			0
82	02/18/2010		MCTNF	Mail Non-Final Rejection			0
81	02/08/2010		CTNF	Non-Final Rejection			0
80	02/04/2010		FWDX	Date Forwarded to Examiner			0
77	02/04/2010		ABN9	Disposal for a RCE / CPA / R129			0
79	02/02/2010		AMS8	Amendment Submitted/Entered with Filing of CPA/RCE			0
78	02/02/2010	01/27/2010	RCEX	Request for Continued Examination (RCE)			72
76	02/02/2010		XT/G	Request for Extension of Time - Granted			0
75	02/02/2010		BRCE	Workflow - Request for RCE - Begin			0
74	10/27/2009		ELC_RVW	Electronic Review			0
73	10/27/2009		ENL_NTF	Email Notification			0
72	10/27/2009		MCTFR	Mail Final Rejection (PTOL - 326)			0
71	10/23/2009		CTFR	Final Rejection			0
70	09/09/2009		FWDX	Date Forwarded to Examiner			0
69	07/27/2009		A/-	Response after Non-Final Action			0
68	05/07/2009		MCTNF	Mail Non-Final Rejection			0
67	05/07/2009		CTNF	Non-Final Rejection			0
65	03/13/2009		FIDC	Finished Initial Data Capture			0
64	02/27/2009		LET	Miscellaneous Incoming Letter			0
63	02/26/2009		FWDX	Date Forwarded to Examiner			0
62	02/26/2009		W/NB	Withdrawal of Notice of Allowance			0
61	02/06/2009		EIDC	Export to Initial Data Capture			0
60	02/02/2009	08/21/2008	HEXA	Mail Examiner's Amendment			45
59	01/30/2009		NN/-	Mail Notice of Allowance	165		0
58	01/30/2009		IREV	Issue Revision Completed			0
57	01/30/2009		DVER	Document Verification			0
56	01/30/2009		N/-	Notice of Allowance Data Verification Completed			0
55	01/30/2009		DOCK	Case Docketed to Examiner in GAU			0
54	01/28/2009		EXA	Examiner's Amendment Communication			0
53	01/28/2009		CHTA	Notice of Allowability			0
48	01/22/2009		MEKIN	Mail Examiner Interview Summary (PTOL - 413)			0
47	10/10/2008		EXIN	Examiner Interview Summary Record (PTOL - 413)			0
46	05/14/2008		DOCK	Case Docketed to Examiner in GAU			0
45	04/21/2008		FWDX	Date Forwarded to Examiner			0
44	03/17/2008		A/-	Response after Non-Final Action			0
43	02/19/2008		MCTNF	Mail Non-Final Rejection			0
42	01/15/2008		CTNF	Non-Final Rejection			0
41	01/15/2008		FWDX	Date Forwarded to Examiner			0
40	01/15/2008		AMS8	Amendment Submitted/Entered with Filing of CPA/RCE			0
38	01/15/2008		FWDX	Date Forwarded to Examiner			0
36	01/15/2008		ABN9	Disposal for a RCE / CPA / R129			0
35	12/11/2007		BRCE	Workflow - Request for RCE - Begin			0
34	12/10/2007		MCTAV	Mail Advisory Action (PTOL - 303)			0
32	11/08/2007		CTAV	Advisory Action (PTOL - 303)			0
31	11/06/2007		FWDX	Date Forwarded to Examiner			0
30	11/06/2007		C614	New or Additional Drawing Filed			0
29	10/01/2007		A/-	Amendment after Final Rejection			0
28	07/19/2007		MCTFR	Mail Final Rejection (PTOL - 326)			0
27	07/16/2007		CTFR	Final Rejection			0
26	04/17/2007	05/14/2004	FWDX	Date Forwarded to Examiner			0
25	04/03/2007		A/-	Response after Non-Final Action			0
24	03/15/2007		MCTNF	Mail Non-Final Rejection	1058		1
23	03/15/2007		CTNF	Non-Final Rejection			0
22	03/15/2007		RCEX	Request for Continued Examination (RCE)			0
21	10/12/2006		XT/G	Request for Extension of Time - Granted			0
20	04/19/2006		DOCK	Case Docketed to Examiner in GAU			0
19	03/15/2006		DOCK	Case Docketed to Examiner in GAU			0
18	12/08/2004		DOCK	Case Docketed to Examiner in GAU			0
22	11/17/2004		IDSC	Information Disclosure Statement considered			0
16	11/17/2004		RCAP	Reference capture on IDS			0
17.7	11/17/2004		MS44	Information Disclosure Statement (IDS) Filed			0
17	11/17/2004		WIDS	Information Disclosure Statement (IDS) Filed			0
14	10/02/2004		TSSCOMP	ITW TSS Processing by Tech Center Complete			0
11	05/12/2004		WROIPE	Application Return from OIPE			0
10	05/12/2004		ROIPE	Application Return TO OIPE			0
9	05/12/2004		COMP	Application Is Now Complete			0
24	04/22/2004		OIPE	Application Dispatched from OIPE			0
13	04/22/2004		IDSC	Information Disclosure Statement considered			0
12.7	04/22/2004		RCAP	Reference capture on IDS			0
12	04/22/2004		MS44	Information Disclosure Statement (IDS) Filed			0
7	04/20/2004		WIDS	Information Disclosure Statement (IDS) Filed			0
6	04/20/2004		ADDFLEE	Additional Application Filing Fees			0
5	04/16/2004		QATHDECL	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant			0
4	03/04/2004		INCD	Notice Mailed--Application Incomplete--Filing Date Assigned			0
3	03/04/2004		L194	Cleared by OIPE CSR			0
2	03/04/2004		CLES	CASE CLASSIFIED BY OIPE			0
23	01/14/2004		SCAN	ITW Scan & PACR Auto Security Review			0
16.7	01/14/2004		IDSC	Information Disclosure Statement considered			0
16	01/14/2004		MS44	Information Disclosure Statement (IDS) Filed			0
1	01/14/2004		WIDS	Information Disclosure Statement (IDS) Filed			0
1	01/14/2004		IECX	Initial Exam Team on			0

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